


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/162,984	12/08/93	DOUGARD	H- 12907281

TRINH, B EXAMINER

12N2/0823

 MORGAN & FINNEGAN, CALVEITI
555 THIRTEENTH STREET, N.W.
480 WEST
WASHINGTON, D.C. 20004-1109

ART UNIT	PAPER NUMBER
1209	7

DATE MAILED: 08/23/94

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined

☒ Responsive to communication filed on 12-23-94 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-5, 13, 24, 30-54, 62, 73, 79-97 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 6-12, 14-23, 25-29, 55-61, 63-72, 74-78 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-5, 13, 24, 30-54, 62, 73, 79-97 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

 1478
EXAMINER'S ACTION

BEST AVAILABLE COPY

Art Unit 1203

Claims 1-5, 13, 24, 30-54, 62, 73, and 79-97 are pending.

Restriction to one of the following inventions is required under 35

U.S.C. § 121:

- I. Claims 1-4, 30-⁵³~~54~~, and 79-97, drawn to compound, compositions, and method of use, classified in Class 549, subclass 510.
- II. Claims 5 and 54, drawn to a method of prepare compound I, classified in Class 549, subclass 510.
- III. Claims 13 and 62, drawn to another method of prepare compound I, classified in Class 549, subclass 510.
- IV. Claims 24 and 73, drawn to another method of prepare compound I, classified in Class 549, subclass 510.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups II, III, or IV and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed

Art Unit 1203

can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as the process of U.S. 5,015,744 wherein an oxazinone reacts with the baccatin to give the compound I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Frederick Calvetti on August 8, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or 305-3592.


Serial No. 08/162,984


-4-

Art Unit 1203

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is (703) 308-4545.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


C. Warren Ivy
Supervisory Patent Examiner
Group 120


TRINH:jd
August 19, 1994